

REMARKS

The Applicants thank the Examiner for the Interview that was conducted on May 17, 2006. Reconsideration of this application is respectfully requested in view of the the foregoing amendment and the following remarks.

Claims 1-19, 22-33, 42-74, and 89-97 are pending in this application. Claims 1 and 42 have been amended, claim 97 added and claims 20-21 canceled. These claim amendments correspond to the amendments suggested by the Examiner during the Interview. No new matter is introduced. Thus, claims 1-19, 22-33, 42-74, and 89-97 are currently pending in the application and subject to examination. Reconsideration and prompt allowance of the claims are respectfully requested.

In the Office Action mailed May 17, 2005, the Examiner stated that claims 1-4, 6-12, 13-22, 24-27, 29-33, 42-45, 48-62, 64-68, 70-74, 86-89, 91-93, 95, and 96 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Boulton (US Patent No. 4,985,697), hereinafter "Boulton", in view of Morales (US Patent No. 5,663,757), hereinafter "Morales" and further in view of U.S. Published Application No. 2005/0144133 to Hoffman, hereinafter "Hoffman". The Examiner stated that claims 46, 49, 90, and 94 were rejected as being allegedly unpatentable over Boulton in view of Morales and further in view of Hoffman and further in view of Pocock et al. (US Patent No. 5,014,125), hereinafter "Pocock".

Applicants note that no grounds of rejection for claims 5, 9, 13, 14, 23, 28, 29, 54, 55, 64, 69, 89-91 and 94 were set forth in the Office Action. Therefore, it is assumed that these claims are allowable.

I. The Cited Art Does Not Disclose Every Limitation in the Claims

A. Independent Claim 1

Claim 1 recites a method for providing electronic commerce using an electronic book, comprising displaying an electronic book, presenting associated with the electronic book an identification of a product or service; receiving a user's selection of the product or service and a request to purchase the selected product or service; performing a transaction to execute the purchase request; receiving from the user an offered price for the product or service; determining whether to accept the offered price; and selectively transmitting an indication of an acceptance of the offered price based upon the determining, wherein the determining step includes determining whether to accept the offered price based upon at least one of the following criteria: an amount of the offered price, any available rebates relating to the selected products or service, any available discounts relating to the selected product or service, or a range of acceptable prices for the selected product or service.

Applicants submit none of Boulton, Morales, and Hoffman disclose or suggest at least the limitation of receiving from the user an offered price for the product or service; determining whether to accept the offered price; and selectively transmitting an indication of an acceptance of the offered price based upon the determining, wherein the determining step includes determining whether to accept the offered price based upon at least one of the following criteria: an amount of the offered price, any available rebates relating to the selected products or service, any available discounts relating to the selected product or service, or a range of acceptable prices for the selected product or service.

In addition, it appears that Hoffman does not qualify as prior art reference unless the portion cited by the Examiner is contained in the unpublished parent application No. 07/705,399. If the Examiner persists in making a rejection based on Hoffman, please point out the portion of the parent application that teaches the cited information. The current application claims priority at least to U.S. Patent Application No. 08/906,469 as noted by the Examiner in the Office Action mailed on August 24, 2004. Therefore, the Applicants submit that Hoffman does not qualify as prior art.

For at least these reasons, Applicants submit that claim 1 is allowable over the cited art. As claim 1 is allowable, Applicants submit that claims 2-4, 6-8, 10-12, 15-19, 22, 24-27, and 30-33, which depend from allowable claim 1, are likewise allowable for at least the reasons set forth above for claim 1.

B. Independent Claim 42

Claim 42 recites an apparatus for providing electronic commerce using an electronic book, comprising: a display module for displaying an electronic book; a presentation module for presenting associated with the electronic book an identification of a product or service, wherein the identification of a product or service is displayed as one of an inset image within the displayed electronic book, an overlaid image on the displayed electronic book, or in place of the displayed electronic book; a receive module for receiving a user's selection of the product or service and a request to purchase the selected product or service; and an execution module for performing a transaction to execute the purchase request.

Applicants submit that none of Boulton, Morales, and Hoffman describe or suggest at least the limitation where the identification of a product or service is

displayed as one of an inset image within the displayed electronic book, an overlaid image on the displayed electronic book, or in place of the displayed electronic book. In addition, the applicants submit that Hoffman does not qualify as prior art, as discussed above for claim 1.

For at least this reason, Applicants submit that claim 42 is allowable over the cited art. As claim 42 is allowable, Applicants submit that claims 43-53, 56-63, 65-68, and 70-74, which depend from allowable claim 42, are likewise allowable for at least the reasons set forth above for claim 42.

C. Independent Claim 93

Claim 93 recites an apparatus for providing electronic commerce using an electronic book comprising: a display module for displaying an electronic book; a presentation module for presenting associated with the electronic book an identification of a product or service; a receive module for receiving a user's selection of the product or service and a request to purchase the selected product or service; and an execution module for performing a transaction to execute the purchase request, wherein the execution module includes: a module for receiving from the user an offered price for the product or service; a determination module for determining whether to accept the offered price; and a transmission module for selectively transmitting an indication of an acceptance of the offered price based upon the determining.

Applicants submit that none of Boulton, Morales, and Hoffman disclose or suggest at least the combination of a determination module for determining whether to accept the offered price. Boulton never discloses or suggests anything connected to price, offers, or requests to purchase. Thus, Boulton does not disclose or suggest

anything relating to a determination module for determining whether to accept the offered price. Likewise, Morales does not disclose or suggest the ability for a user to make a price offer. Morales does not disclose or suggest a determination module for determining whether to accept the offered price. The Examiner relies on Hoffman as teaching "determining whether to accept the offered price."

However, Hoffman merely discloses pre-selecting recommendations to the user based on competitive price comparisons from third party databases. (See Hoffman at [0192]). Hoffman does not disclose or suggest a module for receiving from the user an offered price for a product or service. In addition, Hoffman does not teach a determination module for determining whether to accept the offered price. Hoffman, also, does not disclose or suggest a transmission module for selectively transmitting an indication of an acceptance of the offered price based upon the determining. Furthermore, the applicants submit that Hoffman does not qualify as prior art, as discussed above for claim 1.

For at least these reasons, Applicants submit that claim 93 is allowable over the cited art. Claim 89 contains similar limitations to claim 93, and the Applicants submit that claim 89 is likewise allowable.

As claims 89 and 93 are allowable, Applicants submit that claims 90-92, 95-96, which depend from allowable claims 89 and 93, are likewise allowable for at least the reasons set forth above for claim 93.

D. Independent Claim 97

Applicants invention as set forth in claim 97 is directed toward a method for providing electronic commerce using an electronic book, including presenting

associated with the electronic book an identification of a product or service, wherein the identification of a product or service is displayed as one of an inset image within the displayed electronic book, an overlaid image on the displayed electronic book, or in place of the displayed electronic book.

Applicants submit that none of Boulton, Morales, and Hoffman describe or suggest at least the limitation where the identification of a product or service is displayed as one of an inset image within the displayed electronic book, an overlaid image on the displayed electronic book, or in place of the displayed electronic book.

For at least this reason, Applicants submit that claim 97 is allowable over the cited art.

II. There is an Improper Motivation to Combine References

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See

also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at page 3 and 4. This is an insufficient showing of motivation.

Examiner states on page 3 of the Office Action, in regards to claims 1 and 42 that it would have been obvious to one of ordinary skill in the art to make the combination because "it would provide real-time instantaneous purchases of product or service." However, Boulton does not disclose anything relating to the purchase of product or service. There is no motivation given for making an alteration to Boulton to include the purchase of a product or service. Thus, the stated reason of providing real-time, instantaneous purchases does not relate to the Boulton.

Furthermore, the purchases described in Morales are purchases made in response to an advertisement in a video broadcast program. (See Morales abstract and column 4, lines 17-22). There is no motivation to combine a purchase from a video broadcast program with an electronic book having different learning modes, and even if combined, they do not teach the claimed invention. The only suggestion to combine an electronic book with electronic commerce is found in the present application. The rejection is improper. Therefore, the Applicants respectfully request withdrawal of the rejections.

CONCLUSION

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Furthermore, claims 5, 9, 13, 14, 23, 28, 29, 54, 55, 64, 89-91, and 94 are allowable, as no basis for rejection was set forth in the Office Action. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited. Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300 with reference to docket number 026880-00011.

Respectfully submitted,

Arent Fox PLLC


Sheree T. Rowe
Registration No. 59,068

Customer No. 004372

1050 Connecticut Ave., N.W.
Washington, D.C. 20036-5339
Telephone No. (202) 715-8492
Facsimile No. (202) 638-4810